

REMARKS

I. Status of the Claims

Claims 1-32 are pending. Claims 1-22 stand rejected. Claims 23-32 are withdrawn from consideration by the Examiner as being directed to non-elected subject matter. Claims 1, 18, 21 and 22 have been amended to recite that the anhydrous paste has a water content of less than 1% by weight relative to the total weight of the anhydrous paste. Support for these amendments may be found, for example, in the as-filed Specification at page 5, paragraph [020]. Accordingly, no new matter has been added.

II. The rejection of claims 1-22 under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-22 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,540,791 to Dias ("Dias"), in view of U.S. Patent No. 6,260,556 to Legrand et al. ("Legrand"), and further in view of U.S. Patent No. 6,423,306 to Caes et al. ("Caes") for reasons of record. Final Office Action mailed April 23, 2007, pages 2-5. The Examiner alleges that Dias teaches a hair bleaching composition comprising polydecene, nonionic amphiphilic polymers, peroxygenated salt, an alkaline agent, and surfactants as recited in the rejected claims. *Id.* at 2. The Examiner relies on Legrand and Caes for the disclosure of specific peroxygenated salts, hydrogen peroxide, and gelling agents not disclosed in Dias. *See id.* at 3-4. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent, as taught by

Dias, in view of Legrand, and further in view of Caes. *Id.* at 5. Finally, in responding to Applicants' arguments of record, the Examiner alleges that "Dias shows that use of a polydecene compound having at least 30 carbon atoms in an anhydrous paste for bleaching human keratin fibers was within the level of ordinary skill at the time the claimed invention was made." *Id.* at 7; *see also* Advisory Action at 2. Applicants respectfully disagree and traverse this rejection.

Several basic factual inquiries must be made to determine whether the claims of a patent application are obvious under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467; *see also KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007) and M.P.E.P. § 2141. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." M.P.E.P. § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). *See also KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting Federal Circuit

statement with approval). Exemplary rationales that may support a conclusion of obviousness include, *inter alia*, “simple substitution of one known element for another to obtain predictable results,” or “some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.” M.P.E.P. § 2143 (emphasis added). “To reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person.” M.P.E.P. § 2142.

Applicants maintain that in light of the above-cited guidance from the M.P.E.P., the Examiner has failed to satisfy the initial burden of establishing a *prima facie* case of obviousness. Applicants respectfully submit that the Examiner’s allegation of record that it would have been obvious for a person of ordinary skill in the art at the time the invention was made to have formulated an anhydrous paste as presently claimed lacks merit. The Examiner has provided “mere conclusory statements” and has failed to articulate “reasoning with some rational underpinning” for why one of ordinary skill would choose to modify Dias to arrive at the presently claimed anhydrous paste.

More specifically, while Dias mentions that its compositions may be in the form of a paste, it provides no indication that such a paste is anhydrous. As amended herein, the present claims now recite that the “anhydrous paste” contains “less than 1% water, relative to the total weight of the paste.” Dias discloses that its composition may

comprise a diluent, which is preferably water. *Id.* at col. 44, ll. 65-67. Dias further discloses that the diluent be present at a level preferably between 5% and 99.98%. *Id.* at col. 45, ll. 15-16. All of the examples disclosed in Dias use water as a diluent. *Id.* at col. 50, l. 35. These disclosures, contained throughout Dias, all teach away from an anhydrous product, particularly one with less than 1% water as now recited in the amended claims.

Additionally, as the Examiner has admitted on the record, “Dias. . . does not explicitly teach all the instant claimed percentage of agents.” Final Office Action at 4. To address this deficiency, the Examiner alleged that it would have been “obvious to. . . determine suitable percentages through routine or manipulative experimentation.” *Id.*

In response to Applicant’s arguments of record that it would not have been obvious to choose the claimed ranges, the Examiner, in the Final OA, invoked *In re Woodruff*, alleging that “the applicant must show that the particular range is critical.” *Id.* at 6. However, as Applicants have argued on the record, the Examiner’s reliance on the *Woodruff* case is improper. In *Woodruff*, the court determined that the claimed range (“above 5%”) overlapped the range disclosed in the prior art reference (“about 1-5%”) and held that the applicant must show that the particular range is critical. *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Here, however, there is no need to make such a showing. Dias discloses that its composition may comprise, among a laundry list of organic conditioning oils, polydecene in an amount ranging from about 0.05% to about 3% by weight of the composition. Dias, col. 22, l. 42 - col. 25, l. 15. This range is indeed outside, and significantly lower than, the amount of

the at least one polydecene ranging from 15% to 35% by weight of the total weight of the paste as recited in, for example, present claim 1. There is no overlap.

Further, a person of ordinary skill in the art would not expect polydecene ranging from 15% to 35% by weight to be miscible within the aqueous compositions taught by Dias. This difference in concentration ranges of polydecene reflects the fundamental difference between the invention in Dias, which is directed to a bleaching solution, and the present invention, which is directed to an anhydrous paste. Therefore, one of ordinary skill in the art reading Dias would not have been able to attain the parameters of the instant claims by routine experimentation, unless he or she had the benefit of improper hindsight.

Because Dias makes no more than a passing reference to pastes, it clearly does not contemplate the problems addressed by the present invention. In order to arrive at the presently claimed composition, a person of ordinary skill in the art would first have had to choose to configure the ingredients in Dias in the form of a paste. A person of ordinary skill in the art, prior to the instant invention, would have opted to use mineral oil, combined with a suitable wax to formulate a bleaching paste. See e.g. Example 5 in Legrand. However, the present inventors have found that, certain bleaching pastes, e.g. those formulated with mineral oil, may cause hair to feel coarse or greasy. See Specification at p. 3, para. [010]. They have also found that such compositions are not thermally stable. See *id.* at page 3, para. [012]-[013]. Therefore, a person of ordinary skill in the art would need to conduct additional experiments with specific hydrocarbon oils and discover ranges which would solve these problems. As evinced by the Examples in the present specification, it is the choice of the claimed polydecenes, in

contrast to other hydrocarbon oils or fatty esters, which yields the unexpected benefits of hair with a less greasy feel. Dias provides no suggestion for going through this exercise and no suggestion of the use of an anhydrous paste for bleaching human keratin fibers comprising a polydecene compound having at least 30 carbon atoms in such a high concentration.

Therefore, contrary to the Examiner's allegations, one of ordinary skill in the art upon reading Dias, would not have been able to attain the composition of the instant claims.

As for the secondary references, the Examiner merely relies on Legrand and Caes for the disclosure of specific peroxygenated salts, hydrogen peroxide, and gelling agents. See Final Office Action at 3-4. Neither Legrand nor Caes remedies the deficiencies of Dias as set forth above.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicant respectfully request this rejection be withdrawn.

CONCLUSION

In view of the above arguments, Applicants submit that the present claims are in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

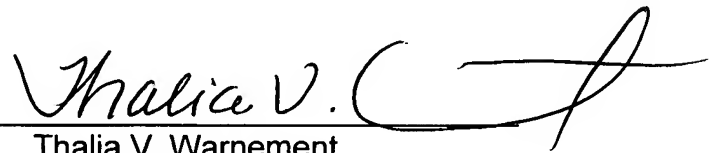
Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,

GARRETT & DUNNER, L.L.P.

Dated: December 21, 2007

By: _____

A handwritten signature in dark ink, appearing to read "Thalia V. Warnement", is written over a horizontal line. The signature is fluid and cursive, with a large, sweeping flourish at the end.

Thalia V. Warnement
Reg. No. 39,064